

Remarks

I. Pending claims

Applicants have canceled claim 20 and incorporated certain definitions of group Ar I from that claim into claims 1 and 27. Claims 2, 21, 37 and 89 have been amended to be consistent with the amendments made to claims 1 and 27. Claim 27 has been amended to recite definitions of certain groups. Those definitions already appear also in claim 1.

Claims 1-2, 7, 11, 14-15, 21-23, 27, 31, 34-37, 49-82, 89, 91 and 93-97 are now pending in this application. The Office Action Summary did not include claim 31 as a pending claim. The listing of claims at the top of page 2 of the Office Action did not include claim 31 and did not include claims 95-97. Claim 31 was amended during earlier prosecution but was not canceled. Claim 31 appears to have been examined because it is included in an obviousness and enablement rejection in the current Office Action. Claims 95-97 were added in the Amendment filed on June 30, 2003, which was entered following the Request for Continued Examination filed on July 30, 2003. Those claims appear to have been examined as well, with the Examiner indicating on page 8 of the Office Action that those claims recite patentable subject matter.

II. Restriction requirement

The Examiner required restriction of the claims into Group I drawn to compounds and a composition and Group II drawn to methods of using the compounds. The Office Action included claim 66 in Group II. Claim 66 recites a pharmaceutical composition, which appears to fall within the subject matter of Group I instead. Applicants affirm the provisional election of the compounds and composition of Group I with traverse. Applicants traverse the rejection because there is no serious burden on the Examiner to conduct a search for all claims of the application.

Claims 50-82 have been withdrawn from consideration. The method of use claims incorporate the subject matter of claims 1 or 27 and should be patentable over any prior art for the same reasons that claims 1 and 27 should be patentable. The rejoinder provisions of MPEP § 821.04 will ultimately require that those claims be examined once the product claims are found allowable: "if applicant elects claims

directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants therefore respectfully request that the Examiner rejoin the method of use claims for examination in this application.

III. Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1-2, 7, 11, 14-15, 20-21, 23, 27, 49 and 89 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of U.S. Patent No. 4,920,131 to Huang et al. The same claims were also rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of U.S. Patent No. 6,376,512 to Jayyosi et al. Applicants respectfully traverse these rejections.

Both the Huang and Jayyosi patents disclose compounds having a quinoline ring in a position that corresponds to the position of group Ar I in the compounds of the claimed invention. Claims 1 and 27, the only independent claims in this application, recite a heteroaryl group Ar I that does not include a quinoline group. The compounds disclosed in Huang and Jayyosi therefore do not anticipate the claimed invention. The documents also do not suggest the claimed compounds from an obviousness perspective either, as neither suggests modifying the disclosed quinoline group to form any Ar I group recited in the present claims.

IV. Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-2, 7, 11, 14-15, 20-21, 23, 27, 31, 34-37, 49, 89, 91 and 93 under 35 U.S.C. § 103(a) as obvious over the disclosure of the Jayyosi patent. Applicants respectfully traverse this rejection.

The Jayyosi patent discloses compounds having a quinoline ring in a position that corresponds to the position of group Ar I in the compounds of the claimed invention. Claims 1 and 27, the only independent claims in this application, recite a heteroaryl group Ar I that does not include a quinoline group. The Jayyosi patent does not render the claimed invention obvious because it does not suggest modifying the disclosed quinoline group to form any Ar I group recited in the present claims. For at least this reason, the rejection should be withdrawn. These remarks do not constitute any

admission that the disclosure of the Jayyosi patent constitutes obviousness prior art to the claimed invention.

V. Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-2, 7, 11, 14-15, 20-21, 23, 27, 31, 34-37, 49, 89, 91 and 93 were rejected under 35 U.S.C. § 112, first paragraph, as not being enabled for the preparation and use of compounds wherein R₁, R₃, R₅, R₇ or R₉, taken together with the carbon atoms to which the R group is linked, form an ethylene group.

Applicants do not agree with the rejection and do not acquiesce in the reasons provided in support of the rejection. Independent claims 1 and 27 have nonetheless been amended to remove the subject matter that the Examiner identified as not enabled. These amendments should overcome the rejection.

VI. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite in reciting that group Ar I may be, for example, a phenyl or cycloalkyl group. Applicants respectfully traverse this rejection.


Claim 22 recites that group Ar I is substituted by a substituent selected from the group consisting of phenyl, substituted-phenyl, thienyl, substituted thienyl, cycloalkyl, straight or branched lower alkyl, fluoro, chloro, alkoxy, aralkyloxy, trifluoromethyl and trifluoromethyloxy. As noted in the claim, the groups listed in Markush format define a substituent on Ar I and do not define Ar I itself. This listing of substituents is not inconsistent with the definition of Ar I. Applicants respectfully request that the Examiner withdraw this rejection.

In view of these amendments and remarks, applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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